

REMARKS

Status of Claims

Claims 18 – 33 are pending in this application. Claims 20 – 22, 25 – 28, and 31 – 33 are allowable. Claims 18 – 19, 23 – 24, and 29 – 30 are rejected.

No claims are amended, cancelled or added by this response.

Allowable Subject Matter

In the Final Office Action of January 18, 2007, (hereinafter “The Office Action”) the Examiner indicated that claims 20 – 22, 25 – 28, and 31 – 33 are allowable. Assignee thanks Examiner for pointing out such subject matter. However, Assignee submits that Examiner has merely pointed out one example of subject matter that is patentable in the claims presented, and that other subject matter may be patentable. Accordingly, Assignee does not acquiesce to any position that such identified subject matter is the only patentable subject matter and reserves the right to pursue claims to other patentable subject matter in this patent application and any related future patent applications.

Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 18 – 19, 23 – 24, and 29 – 30 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,683,981 to Matama (hereinafter “the ‘981 patent”). Assignee respectfully traverses this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

To the extent that the Examiner believes that a reference inherently discloses claimed subject matter the Examiner must provide a rationale or evidence tending to show inherency. MPEP § 2112. Importantly,

(t)o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

MPEP § 2112 quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added).

Examiner believes that the '981 patent teaches or suggests all limitations recited in claim 18. In particular, Examiner appears to assert that the limitations of "replacing the saved information for the first pixel from the first scan with the summed pixel information from the first and second scans" is inherent to the teachings of the '981 patent:

In addition, Matama teaches, "modifying the image processing condition using the relative value stored during the first image reading mode and the digital calibration pattern data that is read during the second image reading mode, in such a way that image processing result concerning at least one of the color and the density in the second image reading mode agrees with the image processing result concerning at least one of the color and the density in the first image reading mode." (col. 4, lines 13-21). Thus in the first scanning, the information for a first pixel is the first density (stored in 40) and in the second scanning, the information for the pixel is the second density (stored in 42). Matama further teaches, "the condition setting section 48 performs various operations including the construction of density histograms and the calculation of various image characteristic quantities such as average density." (col. 8, lines 25-33). In order to calculate the average density the stored first density and the stored second density are

summed, the summed result can be stored in order to divide it by a number of times that the calibration chart is scanned (in this case the number of times is 2) to produce an average value. In the process of averaging, the last summation, result is always replaced the previous summation result in order to do the division for averaging. [Office Action, page 4]

Assignee respectfully submits that in neither the quoted portions of the '981 patent included in the above Office Action excerpt nor elsewhere does the '981 patent disclose, suggest or make obvious, either expressly or inherently, ***replacing the saved information for the first pixel from the first scan with the summed pixel information from the first and second scans*** as advanced by the Examiner. To the extent that Examiner believes that such disclosure is inherent, Assignee respectfully requests that Examiner cite documents showing ***replacing the saved information for the first pixel from the first scan with the summed pixel information from the first and second scans*** is necessarily present in the '981 patent. In the absence of such citation, Assignee respectfully requests withdrawal of rejection of claim 18, and claim 19 depending therefrom, under 35 USC § 103(a).

Claims 23 – 24, and 29 – 30 recite limitations similar to those in claim 18 discussed above. Accordingly, in the absence of citation of documents showing that ***replacing the saved information for the first pixel from the first scan with the summed pixel information from the first and second scans*** is necessarily present in the '981 patent, Assignee respectfully requests withdrawal of rejection of these claims under 35 USC § 103(a).

It is noted that claimed subject matter may be patentably distinguished from the cited art for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that Assignee's failure, if any, to comment directly upon any positions asserted by the Examiner in the Office Action does not indicate agreement or acquiescence with any such asserted positions.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account 50-3703.

If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Timely consideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,

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